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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT PAPER NUMBER

2179

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,112

Applicant(s)

ERICSON ET AL.

Examiner

Doug Hutton

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09172004</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's Response

In Applicant's Response dated 17 September 2004, Applicant amended Claims 2 and 16, added new Claims 24-30, and argued against all objections and rejections previously set forth in the Office Action dated 22 June 2004.

In light of Applicant's amendments, the objection to Claim 2 is withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-13, 15-18, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson, U.S. Patent No. 5,897,648, in view of Lazzouni et al., U.S. Patent No. 5,652,412.

Claim 1:

Henderson discloses a method of editing a document (see Figures 1-5; see Column 1, Line 1 through Column 18, Line 55), the method comprising:

- transferring document information to a printing device adapted to print the document information on a surface (see Column 2, Line 40 through Column 3, Line 22; see Column 3, Line 46 through Column 12, Line 39 – the electronic

document editing system allows a user to send a document to a printer so that the document is printed on paper);

- receiving editing information from a reading device adapted to read position information from the surface (the electronic document editing system allows the user to fix the paper document to a digitizer and edit the document using a digitizer pen);
- interpreting the editing information (the electronic document editing system interprets the handwritten edit markings); and
- changing the document information depending on an interpretation of the editing information, thereby resulting in an updated document (the electronic document editing system converts the handwritten edit markings into digital form and combines the digitized edit with the electronic document).

Henderson fails to expressly disclose a printing device that prints the document information on a surface having a *position-coding pattern*.

Lazzouni teaches a method of editing a document (see Column 4, Lines 8-14; see Column 4, Lines 43-50; see Column 14, Lines 16-33 – the electronic document editing system includes both blank paper and preprinted forms having pixels), the method comprising:

- a printing device that prints the document information on a surface having a position-coding pattern (the electronic document editing system allows the user to print a form on paper having a prerecorded pattern of pixels),

for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer (see Column 1, Lines 11-45; see Column 2, Lines 18-35 – essentially, the electronic document editing system replaces the tablet with the pixel paper).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, to include a printing device that prints the document information on a surface having a position-coding pattern for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer, as taught in Lazzouni.

Claim 2:

Henderson discloses a method of editing a document (see Figures 1-5; see Column 1, Line 1 through Column 18, Line 55), the method comprising:

- transferring document information to a printing device adapted to print the document information on a surface (see Column 2, Line 40 through Column 3, Line 22; see Column 3, Line 46 through Column 12, Line 39 – the electronic

document editing system allows a user to send a document to a printer so that the document is printed on paper);

- receiving editing information from a reading device adapted to read position information from the surface (the electronic document editing system allows the user to fix the paper document to a digitizer and edit the document using a digitizer pen);
- interpreting the editing information (the electronic document editing system interprets the handwritten edit markings); and
- changing the document information depending on an interpretation of the editing information, thereby resulting in an updated document (the electronic document editing system converts the handwritten edit markings into digital form and combines the digitized edit with the electronic document).

Henderson fails to expressly disclose transferring position-coded pattern information to a printing device adapted to print the position-coding pattern on a surface.

Lazzouni teaches a method of editing a document (see Column 4, Lines 8-14; see Column 4, Lines 43-50; see Column 14, Lines 16-33 – the electronic document editing system includes both blank paper and preprinted forms having pixels), the method comprising:

- transferring position-coded pattern information to a printing device adapted to print the position-coding pattern on a surface (the electronic document editing

system allows the user to print forms on paper having a prerecorded pattern of pixels),
for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer (see Column 1, Lines 11-45; see Column 2, Lines 18-35 – essentially, the electronic document editing system replaces the tablet with the pixel paper).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, to include transferring position-coded pattern information to a printing device adapted to print the position-coding pattern on a surface for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer, as taught in Lazzouni.

Claim 3:

Henderson discloses a method according to Claim 1 or 2, further comprising receiving device identity information from the reading device, the identity information associating the editing information with a user of the reading device (the electronic document editing system allows multiple remote users to analyze a document during a teleconference and make edits to the document; the individual users are identified using different pen colors).

Claim 4:

Henderson discloses a method according to Claim 1 or 2, wherein the editing information is associated with a plurality of users, and wherein each user generates at least one editing command with a reading device (the electronic document editing system allows multiple remote users to analyze a document during a teleconference and make edits to the document; the individual users are identified using different pen colors).

Claim 6:

Henderson discloses the method according to Claim 1 or 2, wherein the editing information includes position information related to a position of the reading device on the surface, and wherein the interpretation of the editing information includes interpretation of the position information (the electronic document editing system records the positional information of the digitizer pen as the user edits the document; this information is used during interpretation of the edit markings).

Claim 7:

Henderson discloses the method according to Claim 6, wherein the position information is in the form of sequences of coordinates forming manually generated curves corresponding in form to drawn curves on the printed document (the positional information is in the form of X-Y coordinates used to form handwritten annotations written on the document by the user).

Claim 8:

Henderson discloses the method according to Claim 1 or 2, further comprising displaying the document information of the updated document to a user (the electronic document editing system displays the edited document).

Claim 9:

Henderson discloses the method according to Claim 1 or 2, wherein the step of changing the document information includes adding editing information in the form of handwritten annotations to the document (the electronic document editing system allows the user to make handwritten annotations to the document).

Claim 10:

Henderson discloses the method according to Claim 9, further comprising associating, based on position information included in the editing information, each of the handwritten annotations with a respective portion of the document information (the electronic document editing system incorporates annotations made on the document and displays them in corresponding locations).

Claim 11:

Henderson discloses the method according to Claim 1 or 2, wherein changing the document information includes reformatting one or more parts of the document

information (the electronic document editing system incorporates the edit markings into the electronic document).

Claim 12:

Henderson discloses the method according to Claim 11, wherein said reformatting is chosen from the group of:

- adding text or graphics to said document information; removing text or graphics from said document information; or repositioning text or graphics included in said document information.

Claim 13:

Henderson discloses the method according to Claim 12, wherein adding text includes converting part of the editing information to machine-readable text.

Claim 24:

As indicated in the above discussion, Henderson, in view of Lazzouni, discloses/teaches every element of Claim 1.

Henderson fails to expressly disclose a position-coding pattern that codes a plurality of positions on the surface, each position being coded by a plurality of symbols, wherein each symbol contributes to the coding of more than one of the plurality of positions.

Lazzouni teaches a method of editing a document (see Column 4, Lines 8-14; see Column 4, Lines 43-50; see Column 14, Lines 16-33 – the electronic document editing system includes both blank paper and preprinted forms having pixels), the method comprising:

- a position-coding pattern that codes a plurality of positions on the surface, each position being coded by a plurality of symbols, wherein each symbol contributes to the coding of more than one of the plurality of positions (see Figures 4-6; see Column 6, Line 35 through Column 8, Line 21 – the electronic document editing system includes paper having a pattern of pixels extending over the entire surface of the paper, wherein each pixel defines a unique coordinate position on the surface of the paper; the uniqueness of each pixel is established by an algorithm which orders the lines comprising the pixel),
- for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer (see Column 1, Lines 11-45; see Column 2, Lines 18-35 – essentially, the electronic document editing system replaces the tablet with the pixel paper).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, to include:

- a position-coding pattern that codes a plurality of positions on the surface, each position being coded by a plurality of symbols, wherein each symbol contributes to the coding of more than one of the plurality of positions,

for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer, as taught in Lazzouni.

Claim 15:

This claim merely recites computer software that performs the method of Claims 1 or 2. Accordingly, Henderson, in view of Lazzouni, discloses/teaches every limitation of the claim as specified in the above rejections for Claims 1 and 2.

Claims 16 and 17:

These claims merely recite a computer system that performs the method of Claims 1 and 2, respectively. Accordingly, Henderson, in view of Lazzouni, discloses/teaches every limitation of the claims as specified in the above rejections for Claims 1 and 2.

Claim 18:

This claim merely recites a computer system that performs the method of Claim 3. Accordingly, Henderson, in view of Lazzouni, discloses/teaches every limitation of the claim as specified in the above rejection for Claim 3.

Claim 22:

Henderson discloses a method of editing a document containing information (see Figures 1-5; see Column 1, Line 1 through Column 18, Line 55), the method comprising:

- storing the document information in memory (see Column 2, Line 40 through Column 3, Line 22; see Column 3, Line 46 through Column 12, Line 39 – the electronic document editing system runs on a computer system);
- printing the document information on a surface (the electronic document editing system allows a user to send a document to a printer so that the document is printed on paper);
- enabling an electronic pen to physically mark edit instructions on the surface and to electronically capture the edit instructions (the electronic document editing system allows the user to fix the paper document to a digitizer and edit the document using a digitizer pen);
- receiving through a processor associated with the memory the edit instructions captured by the electronic pen (the electronic document editing system interprets the handwritten edit markings); and
- altering the document information in memory to conform to the edit instructions (the electronic document editing system combines the digitized edit with the electronic document).

Henderson fails to expressly disclose:

- a surface that contains a readable code contained thereon in addition to the printed document information; and
- capturing the edit instructions by reading the readable code proximate the marked edit instructions.

Lazzouni teaches a method of editing a document (see Column 4, Lines 8-14; see Column 4, Lines 43-50; see Column 14, Lines 16-33 – the electronic document editing system includes both blank paper and preprinted forms having pixels), the method comprising:

- a surface that contains a readable code contained thereon in addition to the printed document information (the electronic document editing system allows the user to print forms on paper having a prerecorded pattern of pixels); and
- capturing the edit instructions by reading the readable code proximate the marked edit instructions (the electronic document editing system receives edit markings made by the user and positions the edits according to their proximity to the pattern of pixels),

for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer (see Column 1, Lines 11-45; see Column 2, Lines 18-35 – essentially, the electronic document editing system replaces the tablet with the pixel paper).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, to include:

- a surface that contains a readable code contained thereon in addition to the printed document information; and
- capturing the edit instructions by reading the readable code proximate the marked edit instructions,

for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer, as taught in Lazzouni.

Claim 23:

Henderson fails to expressly disclose a readable code that is a position coding pattern.

Lazzouni teaches a readable code that is a position coding pattern (see Figures 4-6; see Column 4, Lines 8-14 – the electronic document editing system includes encoded paper defining pixels) for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer (see Column 1, Lines 11-45; see Column 2, Lines 18-35 – essentially, the electronic document editing system replaces the tablet with the pixel paper).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, to

include a readable code that is a position coding pattern for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer, as taught in Lazzouni.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson, U.S. Patent No. 5,897,648, in view of Lazzouni et al., U.S. Patent No. 5,652,412, and further in view of Moody et al., U.S. Patent No. 5,890,177.

Claim 5:

As indicated in the above discussion, Henderson, in view of Lazzouni, discloses/teaches every element of Claim 4. Henderson also discloses editing commands that are generated by the plurality of users in an ordered sequence (the electronic document editing system allows multiple remote users to analyze a document during a teleconference and make edits to the document; the individual users are identified using different pen colors, and their edits are stored in the system).

Henderson, in view of Lazzouni, fails to expressly disclose editing commands identified by at least a timestamp associated with each editing command.

Moody teaches a method of editing a document (see Figures 1-5; see Column 1, Line 1 through Column 14, Line 40), the method comprising:

- editing commands generated by a plurality of users that are in an ordered sequence identified by at least a timestamp associated with each editing

command (the electronic document editing system records a timestamp that indicates when the edits were made by each of the plurality of users), for the purpose of determining when a particular edit was made.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, in view of Lazzouni, to include editing commands generated by a plurality of users that are in an ordered sequence identified by at least a timestamp associated with each editing command for the purpose of determining when a particular edit was made, as taught in Moody.

Claims 14 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson, U.S. Patent No. 5,897,648, in view of Lazzouni et al., U.S. Patent No. 5,652,412, and further in view of Dymetman et al., U.S. Patent Application Publication No. US 2002/0020750 A1.

Claim 14:

As indicated in the above discussion, Henderson, in view of Lazzouni, discloses/teaches every element of Claims 1 or 2. Lazzouni also discloses initially registering said document in a pattern administration unit, wherein said pattern administration unit assigns a unique subset of said position-coding pattern (the electronic document editing system uses different coding algorithms for different

patterns that are placed onto each paper document; the system stores each of these different patterns when they are created).

Henderson, in view of Lazzouni, fails to expressly disclose a pattern administration unit that assigns a unique subset of said position-coding pattern *to each page of said document*.

Dymetman teaches a method of manipulating a document (see Figures 3-7; see Paragraphs 0013-0017), the method comprising:

- a pattern administration unit that assigns a unique subset of said position-coding pattern to each page of said document (the document editing system uses dataglyphs to identify particular pages and to specify a function to be performed regarding that particular page),

for the purpose of specifically identifying a particular page and indicating a function to be performed regarding that particular page (see Paragraphs 0013-0017).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, in view of Lazzouni, to include a pattern administration unit that assigns a unique subset of said position-coding pattern to each page of said document for the purpose of specifically identifying a particular page and indicating a function to be performed regarding that particular page, as taught in Dymetman.

Claim 19:

This claim merely recites a computer system that performs the method of Claim 14. Accordingly, Henderson, in view of Lazzouni, and further in view of Dymetman, discloses/teaches every limitation of the claim as specified in the above rejection for Claim 14.

Claim 20:

Henderson discloses a means for receiving editing information that is included in a pattern administration unit (the document editing system receives and collects and stores the edits from the multiple remote users).

Claim 21:

Henderson discloses a means for receiving editing information that is included in a local processing unit (the document editing system receives and collects and stores the edits from the multiple remote users).

Claim 25:

As indicated in the above discussion, Henderson, in view of Lazzouni, and further in view of Dymetman, discloses/teaches every element of Claim 14. Lazzouni also discloses a pattern administration unit that, in the registering, receives document data indicative of the document (the electronic document editing system allows the user to

print a form on paper having a prerecorded pattern of pixels; the form is "document data" that is "indicative of the document").

Henderson, in view of Lazzouni, fails to expressly disclose a pattern administration unit that, in the registering, receives document data indicative of the document *and of a number of document pages*.

Dymetman teaches a method of manipulating a document (see Figures 3-7; see Paragraphs 0013-0017), the method comprising:

- a pattern administration unit that, in the registering, receives document data indicative of the document (see Paragraphs 0013-0017 – the system includes dataglyphs to identify documents) and of a number of document pages (see Paragraphs 0007 and 0016 – the system includes page identifiers; moreover, the disclosure indicates that the prior art includes paper pixels that include page numbers),

for the purpose of specifically identifying particular documents and pages within a document (see Paragraphs 0013-0017).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, in view of Lazzouni, to include:

- a pattern administration unit that, in the registering, receives document data indicative of the document and of a number of document pages,

for the purpose of specifically identifying particular documents and pages within a document, as taught in Dymetman.

Claim 26:

As indicated in the above discussion, Henderson, in view of Lazzouni, and further in view of Dymetman, discloses/teaches every element of Claim 25. Lazzouni also discloses document data that includes the document (the electronic document editing system allows the user to print a form on paper having a prerecorded pattern of pixels; the form is "document data" that is "includes the document").

Claim 27:

As indicated in the above discussion, Henderson, in view of Lazzouni, and further in view of Dymetman, discloses/teaches every element of Claim 16. Lazzouni also discloses registration means which is arranged to initially register the document in a pattern administration unit comprising a database of the position coding pattern, the pattern administration unit being arranged to assign a unique subset of the position-coding pattern (see Figures 4-6; see Column 6, Line 35 through Column 8, Line 21 – the electronic document editing system uses different coding algorithms for different patterns that are placed onto each paper document; the system stores each of these different patterns when they are created).

Henderson, in view of Lazzouni, fails to expressly disclose a pattern administration unit that assigns a unique subset of said position-coding pattern *to each page of the document*.

Dymetman teaches a method of manipulating a document (see Figures 3-7; see Paragraphs 0013-0017), the method comprising:

- a pattern administration unit that assigns a unique subset of said position-coding pattern to each page of the document (the document editing system uses dataglyphs to identify particular pages and to specify a function to be performed regarding that particular page),

for the purpose of specifically identifying a particular page and indicating a function to be performed regarding that particular page (see Paragraphs 0013-0017).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, in view of Lazzouni, to include a pattern administration unit that assigns a unique subset of said position-coding pattern to each page of the document for the purpose of specifically identifying a particular page and indicating a function to be performed regarding that particular page, as taught in Dymetman.

Claim 28:

As indicated in the above discussion, Henderson, in view of Lazzouni, and further in view of Dymetman, discloses/teaches every element of Claim 27. Lazzouni also discloses storage means and registration means that are included in a computer device (see Figure 7).

Claim 29:

As indicated in the above discussion, Henderson, in view of Lazzouni, and further in view of Dymetman, discloses/teaches every element of Claim 27. Lazzouni also

discloses a registration means that is arranged to transfer document data indicative of the document to the pattern administration unit (the electronic document editing system allows the user to print a form on paper having a prerecorded pattern of pixels; the form is "document data" that is "indicative of the document").

Henderson, in view of Lazzouni, fails to expressly disclose a registration means that is arranged to transfer document data indicative of the document *and of a number of document pages* to the pattern administration unit.

Dymetman teaches a method of manipulating a document (see Figures 3-7; see Paragraphs 0013-0017), the method comprising:

- a registration means that is arranged to transfer document data indicative of the document (see Paragraphs 0013-0017 – the system includes dataglyphs to identify documents) and of a number of document pages to the pattern administration unit (see Paragraphs 0007 and 0016 – the system includes page identifiers; moreover, the disclosure indicates that the prior art includes paper pixels that include page numbers),

for the purpose of specifically identifying particular documents and pages within a document (see Paragraphs 0013-0017).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, in view of Lazzouni, to include:

- a pattern administration unit that, in the registering, receives document data indicative of the document and of a number of document pages to the pattern administration unit,

for the purpose of specifically identifying particular documents and pages within a document, as taught in Dymetman.

Claim 30:

As indicated in the above discussion, Henderson, in view of Lazzouni, and further in view of Dymetman, discloses/teaches every element of Claim 29. Lazzouni also discloses document data that includes the document (the electronic document editing system allows the user to print a form on paper having a prerecorded pattern of pixels; the form is "document data" that is "includes the document").

Response to Arguments

Applicant's arguments filed 17 September 2004 have been fully considered but they are not persuasive.

Arguments for Claim 1:

Applicant argues that Lazzouni fails to teach editing documents with no further explanation. See *Applicant's Response* – Page 14, first full paragraph through Page 15, first partial paragraph.

The examiner disagrees.

Firstly, Applicant's argument fails to comply with 37 CFR 1.111(b) because it amounts to a general allegation that the claim defines a patentable invention without specifically pointing out how the language of the claim patentably distinguishes it from the reference. Simply stating that certain limitations of a claim are not disclosed in the cited reference with no analysis of how the specific language of each limitation is distinguishable from the subject matter disclosed in the cited reference fails to meet the requirement of 37 CFR 1.111(b) that Applicant "specifically [point] out how the language of the claims patentably distinguishes them from the references." Instead, Applicant simply states, "it's not there."

Secondly, as indicated in the above rejection for Claim 1, Lazzouni teaches this limitation in that the electronic document editing system includes preprinted forms having pixels upon which a user may write. Thus, the paper in Lazzouni has both a document (the form) and a position-coding pattern (the pixels), and a user may write upon the form using the pen. See Lazzouni – Column 4, Lines 8-14; Column 4, Lines 43-50; Column 14, Lines 16-33. Accordingly, Lazzouni teaches "editing documents."

Applicant argues that Henderson and Lazzouni are improperly combined because one of ordinary skill in the art would not be motivated to modify a device that includes a digitizing tablet with an arrangement to read position codes imprinted on a surface. See *Applicant's Response* – Page 15, first full paragraph.

The examiner disagrees.

Lazzouni expressly teaches inputting handwritten data and text into a computer system. In the "Background of the Invention," Lazzouni discusses the pen and tablet system capable of use only when connected to a host computer. Lazzouni suggests that it is desirable to allow entry of handwritten information without the need for a host computer, thus permitting portable and field use of the input device. See Lazzouni – Column 1, Lines 11-45; Column 2, Lines 18-35. Therefore, Lazzouni replaces the digitizing tablet with the pixel paper, and thus, one of ordinary skill in the art would be motivated to modify replace the digitizing tablet in Henderson with the pixel paper in Lazzouni whenever portability is desired. Moreover, Lazzouni indicates to one of ordinary skill that a digitizing tablet and the pixel paper are interchangeable

Applicant argues that replacing the digitizing tablet in Henderson with the pixel paper in Lazzouni would "change the principle operation of the prior art invention being modified" and render the apparatus of Henderson inoperable. See *Applicant's Response* – Page 15, second full paragraph through Page 16, first partial paragraph.

The examiner disagrees.

Both devices disclosed in Henderson and Lazzouni are used to input handwritten data into a computer system. The handwritten data may be input using either the digitizing tablet of Henderson or the pixel paper of Lazzouni. Replacing the digitizing tablet of Henderson with the pixel paper of Lazzouni will not make the device "inoperable." Rather, it will allow the user to disconnect from a host computer and

provide portability for the handwritten input device so that the device may be used in the field.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

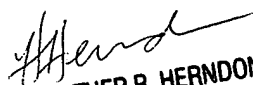
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH

December 2, 2004


HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100